

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WARREN W. MCALPINE and MARYANN CLARKE

Appeal No. 1997-1896
Application No. 08/476,389¹

ON BRIEF

Before THOMAS, JERRY SMITH, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 20, which is the only claim pending in this application.

We REVERSE.

¹ Application for patent filed Jun. 7, 1995.

BACKGROUND

The appellants' invention relates to a slotted core telecommunications cable. An understanding of the invention can be derived from a reading of claim 20, which is reproduced below.

20. A telecommunications cable, comprising: a longitudinally extending spacer having at least an outer layer thereof formed of plastic material having a melt flow index of equal to or greater than about 0.65 g/10 min, said spacer having formed in said outer layer a plurality of longitudinally extending helical grooves each for supporting a longitudinally extending telecommunications member therein, each of said grooves having a cross-sectional shape transverse to its longitudinal extent generally in the form of an U-shape with a flat bottom, two corners, and two walls, each wall substantially perpendicular to said bottom and joined to said bottom at one of said corners, and a plurality of longitudinally extending ribs each between two adjacent grooves and each delimiting two of said groove walls, each rib having a longitudinally extending base between adjacent groove corners whose thickness does not exceed about 1.3 mm; and an outer jacket surrounding said spacer.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rawlyk	5,188,883	Feb. 23, 1993
Brosius et al. (Brosius)	5,371,144	Dec. 06, 1994

Claim 20 stands rejected under 35 U.S.C. § 103 as being unpatentable over Rawlyk in view of Brosius.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 11, mailed Dec. 19, 1996) for the examiner's reasoning in support of the rejection, and to the appellants' brief (Paper No. 10, filed Nov. 19, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claim, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a ***prima facie*** case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the ***prima facie*** case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); **In re Hedges**, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); **In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and **In re**

Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

Regardless of whether the examiner's analysis is correct, it sufficiently makes the required factual determinations to support a ***prima facie*** case of obviousness. Since appellants have presented several substantive arguments in response to the examiner's rejection, we consider the determination of obviousness based upon the totality of the evidence and the relative persuasiveness of the arguments.

Appellants admit that the prior art references individually teach components of the claimed invention, but argue that it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as maintained by the examiner. (See brief at pages 2-3.) We agree with appellants. We find that the examiner has not provided a convincing line of reasoning as to why one of ordinary skill in the art would have been motivated to combine the general teaching of using a core with grooves as taught by Rawlyk with the specific materials as taught by Brosius.

The examiner applies Rawlyk which is a teaching for a composite tape which is to be used in telecommunications cables. Rawlyk teaches the general use of a spacer similar to that set forth in claim 20. Rawlyk merely states that core, 12, has helical grooves to house transmission elements and a strength member, 16, in the center. The examiner has not cited any portion of Rawlyk which would have suggested any

specific material for the core and the examiner has not provided a line of reasoning or motivation to use one type of material over another. Moreover, the examiner has not identified any portion of Rawlyk to teach or suggest the dimensions set forth in claim 20 nor have we found any such motivation within the four corners of Rawlyk.

With respect to the combination of the references, the examiner states that it would have been obvious to one of ordinary skill in the art at the time of the invention to “use the plastic material as taught by Brosius et al. for the plastic core member of Rawlyk for easy molding.” (See answer at page 5.) Furthermore, the examiner has stated that “[t]he motivation for combining the references is the dual benefit of the plastic material having both mechanical strength and easy molding.” (See answer at page 6.) We disagree. The examiner has not provided a teaching or a convincing line of reasoning as to why it would have been obvious to one of ordinary skill in the art at the time of the invention to use the particular plastic of Brosius in a telecommunication cable or related product as a motivation for the combination. Brosius is silent as to its use in cables. Therefore, we find that the examiner has used impermissible hindsight reconstruction in rejecting claim 20. Therefore, we will not sustain the rejection of claim 20.

CONCLUSION

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To summarize, the decision of the examiner to reject claim 20 under 35 U.S.C.
§ 103 is reversed.

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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